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EXAMINER

BROWN, TIMOTHY M

ART UNIT

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Please find below and/or attached an Office communication concerning this application or proceeding.

#11

42

# Office Action Summary

Application No.

09/874,010

Applicant(s)

NAKAGAWA, SHIGEHARU

Examiner

Tim Brown

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 12/19/02 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

1. This non-final Office Action is responsive to Applicant's Amendment submitted December 19, 2002. Amendments to the claims have been entered. New claims 25-44 have been entered and examined.

***Claim Rejections - 35 USC § 112***

2. The rejection of claim 21 made under 35 U.S.C. 112, second paragraph, has been withdrawn in response to Applicant's amendment.

***Response to Arguments***

3. Claims 1 and 20

Applicant argues Farros et al. (US 5,930,810) (hereinafter "Farros") fail to teach or suggest having a customer access a home page over the world wide web (Amendment, p. 16). The Examiner respectfully disagrees in that Farros expressly discloses a "client/server form which may typically be found in an office environment, or in a distributed network *such as the internet.*" (Col. 7, lines 7-11; emphasis added). Furthermore, Applicant admits Farros teaches "placing [a] print order via the internet . . . ." (Amendment, p. 17). Thus, Farros clearly teaches having a customer access a home page over the world wide web.

Applicant further alleges that unlike his invention which stores programming on a Website server, Farros provides that the programs and storage needed to electronically create the document for printing are stored at the user's computer (Amendment, p. 16). However, this argument fails for two reasons. First, the programs and storage recited in claim 1 are not necessarily limited to being stored on a Website server. Claim 1 merely recites "an editor *connected to said first memory* to edit said first draft . . . ." (Emphasis added). Thus, the editor

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could reside on any computer system that is equipped with network access. Second, Farros teaches a server that is equipped with programming and storage for electronically creating documents for printing.<sup>1</sup> Farros discloses one embodiment of its network printing system wherein an executable program module (for implementing the function of the printing system) is “coupled to a server computer which is coupled to [a] client computer via network interfaces . . . .” (Col. 7, lines 16-24). Applicant admits Farros teaches a system wherein “the customer connects to software for producing the document and placing the print order via the internet . . . .” Thus, Farros clearly teaches storing editing programming on a Website server.

4. Claims 1, 11 and 20

Applicants suggest Farros does not disclose connecting to a print agency via the Internet (Amendment, p. 16). The Examiner respectfully disagrees. First, claim 1 fails to recite a “printing agency.” Second, Farros discloses connecting to a print agency via the Internet. Applicant admits Farros discloses a system wherein “the customer connects to software for producing the document and placing the print order via the internet . . . .” (Amendment, p. 17). This admission is consistent with Farros’ teaching of a server that is equipped with programming and storage for electronically creating documents as discussed under claims 1 and 20 *supra*. Furthermore, Farros teaches connecting to a *print agency*. The term “agency” is broadly defined as an “instrumentality.” (Merriam-Webster’s Collegiate Dictionary, Tenth Ed. (1999)). Clearly, Farros teaches an instrumentality for printing documents in that Farros is directed to a printing system “which allows certain products to be printed by a remotely

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<sup>1</sup> The Examiner notes that Applicant has admitted Farros teaches a system wherein “the customer connects to software for producing the document and placing the print order via the internet . . . .” (See Amendment, p. 17).

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located printing facility.” (Abstract). Consequently, Farros teaches connecting to a print agency via the Internet.

Regarding claim 11, Applicant argues that the Examiner’s use of Official Notice was improper. In particular, Applicant contends receiving an online estimate from a print agency for a print product is not old and well known in the art (Amendment, p. 17). Examiner’s use of Official Notice was limited to the proposition that receiving an online estimate for a service is old and well known in the art (*see* Office Action, p. 6). This is clearly supported by Goldberg et al. (US 6,196,146) which discloses providing an online cost estimate for a custom-designed embroidery product (*see* Abstract). The fact that the invention of claim 11 is directed to receiving an estimate for a print product from a printing agency is of no consequence.

According to MPEP § 2106 part VI, “a process that differs only with respect to nonfunctional descriptive material that does alter how the process steps are to be performed to achieve the utility of the invention” does not render the claimed invention non-obvious. Thus, the fact that the invention provides the online estimate is received from a printing agency recitation of a printing agency does not provide a patentable distinction over Goldberg et al.. In both cases, the utility of the invention is achieved by providing users with an online estimate for a customized product. Therefore, the invention of claim 11 is obvious in view of the prior art.

Further regarding claim 11, Applicant argues Farros fails to disclose the step of editing at the print agency wherein the print agency is connected to the customer’s terminal by the Internet.

Applicant states:

[t]he editor in Applicant’s claims needs to both be knowledgeable of computer software, of digital imaging, of printing, and of the internet and much more, a combination of skills that did not exist in the past, making this fifth limitation neither taught nor suggested by the prior art.

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Furthermore, the editor, unlike the customer, specializes in electronic files and image editing, a feature that is not old and well known in the prior art.

(Amendment, p. 18).

First, the Examiner notes none of these limitations are recited in claim 11. Rather, claim 11 merely recites "editing said first draft of said customer's print job at said print agency . . . ."

Second, Farros discloses editing at the print agency wherein the print agency is connected to the customer's terminal by the Internet. Farros discloses connecting the customer's computer to the print agency via the Internet as discussed *supra*. Farros also teaches "editing" at the location of the print agency. The term "edit" is defined as "to prepare for publication or public presentation." (Merriam-Webster's Collegiate Dictionary, Tenth Ed. (1999)). According to Farros, print orders are transmitted from the client system to a remote printing facility where they may be printed, decrypted<sup>✓</sup> and/or decompressed<sup>✓</sup> (col. 5, lines 9-20 and 26-29). Printing, decrypting and decompressing are all activities that are directed to preparing a document for publication. Thus, Farros teaches editing at the location of the print agency.

Editing

Regarding claim 11, Applicant argues that the Examiner's use of Official Notice was improper. In particular, Applicant contends editing a customer's print job at a print agency connected to the customer via the Internet is not old and well known in the art (Amendment, p. 18). However, an article from M2 Presswire ("TEKTRONIX: Color experts partner to sponsor Colorize.com" M2 Presswire (April 22, 1998)) ("Presswire") discloses an Internet homepage that offers users software that permits them to manipulate and otherwise alter documents in the environment of the homepage (p. 2). Consequently, editing a customer's print job at a print agency connected to the customer via the Internet is old and well known in the art. Therefore, the Examiner's use of Official Notice is proper.

Applicant further contends that “the notion that a traditional print shop may have editing services does not infer that it is obvious to have an internet print agency that does [editing] electronically.” (Amendment, p. 19). The Examiner respectfully disagrees. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have been obvious to modify Farros to include an editing service because the objective, creating a quality document, is the same in both references. Therefore, it would have been obvious to modify Farros to include an Internet print agency that performs electronic editing.

5. Claims 14 and 15

Applicant contends the Office Action failed to address claims 14 and 15 (Amendment, p. 19). The Examiner notes the Office Action, at pages 14 and 15, rejected these claims under Farros in view of an article from InformationWeek (Chabrow E. “iPrint: Self-Service Printing,” InformationWeek (December 13, 1999)).

6. Claim 16

Regarding claim 16, Applicant argues “editing done in an internet electronic environment” is not old and well known in the art (Amendment, p. 19). However, Truong (US 6,151,609) discloses a remote editor system “for remotely editing files stored on a remote Internet server” (Abstract). Therefore, editing done in an internet electronic environment is old and well known in the art.

7. Claim 17

Regarding claim 17, Applicant again contends Farros does not pertain to an internet print service (Amendment, p. 20). However, as noted above, Farros discloses a “client/server form which may typically be found in an office environment, or in a distributed network *such as the internet.*” Furthermore, Farros is directed to a print service because the invention of Farros is titled “printing system with pre-defined user modifiable forms and local and remote printing.” Therefore, Farros pertains to an internet print service.

Applicant also argues it is not obvious modify Farros to include steps wherein “a document to be later printed is edited by the print agency, the editing is reviewed by the customer, and a second editing is again conducted at the print agency.” (Amendment, p. 19). Applicant specifically points out it is not obvious to have a internet editing service because special technical expertise is needed to edit electronic documents over the Internet (Id.). The Examiner respectfully disagrees. For example, Farros discloses that its printing system “provides an easy to user [sic] Graphical User Interface which includes push buttons displayed on the visual display which may be selected by the user to navigate from one part of the printing system to another, to change sizes of forms, change fonts, colors and other attributes of the forms.” (col. 2, lines 60-67). Thus, “special technical expertise” is not required to operate an Internet print service.



*Claim Rejections - 35 USC § 102*

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. **Claims 1, 2 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Farros.**

Regarding claim 1, Farros teach an Internet printing apparatus, comprising:

a home page that can be accessed by a customer over the World Wide Web, said home page comprising instructions of how a customer can request a print job, said home page further comprising a form that may be accessed through a hyperlink, said form enabling a customer to request said print job (col. 2, lines 24-27 and 51-55; col. 4, lines 27-30; col. 7, lines 46-51 and 53-65; and col. 8, lines 15-17;)

a first memory storing a customer's printing parameters and a first draft of said customer's print job (col. 5, lines 14-20);

an editor connected to said first memory to edit said first draft of said customer's print job creating a finalized version of said customer's print job, said editor being distinguishable from said customer<sup>2</sup> (col. 8, lines 30-36 and 42-67; Fig. 4);

a second memory connected to said editor storing said finalized version of said customer's print job (col. 11, lines 45-52); and

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<sup>2</sup> The Examiner notes Fig. 4 discloses the remotely-located storage and printing facility. This teaching relies on the broad definition of "edit" discussed under claim 11 in the Response to Arguments. Because "editing" is essentially preparing a document for publication, Farros' remotely-located printing facility, which prints the users' documents, discloses the claimed editor.

an output device connected to said second memory via network printing to download said finalized version onto a recording media at a location of said customer's choice (col. 2, lines 27-32).

Regarding claim 2, Farros teach an apparatus wherein said customer's first draft and said finalized version of said customer's print job comprises text, images and pictures (col. 3, lines 66-67; col. 4, lines 1-10; and col. 8, lines 58-60).

Regarding claim 10, the examiner notes that the limitation "wherein said output device prints 180 sheets per minute" is functional claim language and carries little weight because it does not provide any physical limitation. Moreover, Farros teach an output device that is reasonably capable of printing 180 sheets per minute (col. 2, lines 27-32).

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**11. Claims 3-8, 11-13, 16-18 and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farros in view of Official Notice.**

Regarding claim 3, Farros teach all the limitations discussed under claim 1 above. Farros further teach an Internet printing apparatus wherein said printing parameters comprise: size of paper to be printed on (col. 4, lines 27-30; col. 8, lines 25-27; and col. 9, lines 4-6); color of paper to be printed on (col. 9, lines 2-4; and col. 10, lines 57-60) quality of paper to be printed on

(col. 9, lines 4-6) and col. 10, lines 57-60); quantity to be printed (col. 10, lines 41-43); and type and location of output device (col. 10, lines 57-60; and col. 11, lines 14-19 and 54-61).

Farros do not teach an Internet printing apparatus wherein said printing parameters comprise whether or not to print a finished cover page and whether or not to bind each document printed and a type of binding to be used. However, the examiner takes Official Notice that determining whether or not to include a cover page and the type of binding to be used for a print job is old and well known in the art. Therefore, at the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art, to modify the system of Farros to include accepting printing parameters comprising whether or not to print a finished cover page and whether or not to bind each document printed and a type of binding to be used. This modification would permit the user to customize his print job and provide for a bound print product with pages collectively attached such that their order is maintained.

Regarding claims 4-7, Farros teach all the limitations discussed under claim 1 above. Farros do not teach an Internet printing apparatus further comprised of said output device being selected from the group consisting of a toner type digital printer, a CD-ROM printing device, an ink jet type printer and a magnetic optical disk read/write device. However, the examiner takes Official Notice that these output devices are old and well known in the art. Therefore, at the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art, to modify Farros to include an output device selected from the group consisting of a toner type digital printer, a CD-ROM printing device, an ink jet type printer and a magnetic optical disk read/write device. Such a modification would provide at least two benefits. First, the user would

be afforded a range of quality for his print job. Second, the user could select a format for his print job that is compatible with his personal system.

Regarding claim 8, Farros teach an Internet printing apparatus wherein editing comprises changes made by said editor to said first draft submitted by said customer over said Internet to said first memory, said changes include changes specified by said customer and changes initiated by said editor (Abstract; and col. 8, lines 30-36 and 42-50).

Regarding claims 11 and 25, Farros teach a method for printing text, images and pictures, comprising the steps of:

connecting, via the Internet, a customer at a computer terminal to a printing agency (Abstract; col. 2, lines 20-24, 42-46 and 65-67; col. 5, lines 9-20, 26-28; and 56-58; and col. 7, lines 6-11);

filling out a print request form by said customer and submitting said print request form over the Internet to said printing agency (col. 2, lines 24-30; col. 5, lines 3-5; and col. 7, lines 46-65);

transmitting a first draft of a customer's print job comprising text, images and pictures from said customer's computer to said printing agency over the Internet and storing said first draft in a first memory (col. 2, lines 27-32 and 65-67; and col. 5, lines 9-20 and 26-28) ;

editing said first draft of said customer's print job at said print agency and storing a resulting document in a second memory (col. 2, lines 25-30; and col. 10, lines 62-67); and

outputting said document from said second memory to a remote output device of the customer's choice (col. 2, lines 27-32).

Farros do not teach receiving a cost estimate from said printing agency. However, the examiner takes Official Notice that receiving an online estimate for a service is old and well known in the art. Therefore, at the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art, to modify Farros to include receiving a cost estimate from said printing agency because adding this step would permit the customer to compare printing agencies and select the printing agency with the lowest price.

Farros do not teach editing said first draft of said customer's print job at said print agency. However, the examiner takes Official Notice that editing a customer's print job at a printing agency's location, by printing agency personnel, is old and well known in the art. Therefore, at the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art, to modify Farros to include editing said first draft of said customer's print job at said print agency in order to provide editing by a second, independent party in order to identify and correct errors that may have been overlooked by the customer.

Regarding claim 12, Farros teaches a method of printing text, images and pictures wherein said request form asks the customer the quantity to be printed (col. 10, lines 41-43), a paper size (col. 4, lines 27-30; col. 8, lines 25-27; and col. 9, lines 4-6),

Farros does not teach a method of printing text, images and pictures wherein said request form asks the customer a number of pages in said first draft, whether or not a cover is to be made, and whether or not each document is to be bound. However, the examiner takes Official Notice that determining these parameters, by a printing agency, in connection with a print job, is old and well known in the art. Therefore, at the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art, to modify the teachings of Farros to include

asking the customer a number of pages in said first draft, whether or not a cover is to be made, and whether or not each document is to be bound. Asking the customer the number of pages in said first draft would enable the printing agency to determine a print job cost and ensure the accuracy of the customer's order. Asking the customer whether or not a cover is to be made and whether or not each document is to be bound would further enable the customer to customize his print job and bind his print product.

Regarding claim 13, Farros teach all the limitations discussed under claim 11 above. Farros further teach a method for printing text, images and pictures wherein said request form further asks said customer the color and quality of the paper to be printed on (col. 9, lines 2-6) and the location of where the documents are to be printed out (col. 2, lines 27-32).

Farros do not specifically teach a method for printing text, images and pictures wherein said request form further asks said customer the type of output device the documents are to be printed out on and the type of binding if any. However, the examiner takes Official Notice that having a printing agency request print product parameters, such as the type of print product binding and the type and/or quality of printed product media are old and well known in the art. For example, printing agency service forms have, for a long time, enabled a customer to indicate whether the customer would like his product printed as a slide show or overhead transparency. Another old and well known printing agency request is whether the customer would like a spiral or taped binding. Therefore, at the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art to modify Farros to include a service request form wherein the form further asks said customer the type of output device the documents are to be printed out on

and the type of binding if any. This step would allow the customer to select a customized printed product that is most suited for his particular need.

Regarding claim 16, Farros teach all the limitations discussed under claim 11 above. Farros do not teach a method for printing text, images and pictures wherein said editing step is comprised of enlarging or reducing images and pictures of said first draft of said customer's print job. However, the examiner takes Official Notice that having a printing agency determine routine printing parameters such as whether a particular image is to be enlarged or reduced, so as to improve the fit of the image on a document, is old and well known in the art. Therefore, at the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art, to modify Farros to include an editing step comprising enlarging or reducing images and pictures of said first draft of said customer's print job in order to produce the customer's printed product with images included. For example, a photograph of a customer may require reducing in order for it to appear on a printed business card.

Regarding claim 17, Farros teach all the limitations discussed under claim 11 above. Farros do not teach a method for printing text, images and pictures wherein said editing step is comprised of:

- conducting a first editing by said printing agency of said first draft of said customer's print job;
- sending said edited first draft of said customer's print job back to the customer over the Internet;
- conducting a further revisions to said print job by said customer; sending said revised print job back to the printing agency;

- conducting a second editing by said printing agency to said revised print job to produce a finalized document; and
- storing said finalized document in said second memory at said printing agency.

However, the examiner takes Official Notice that having a printing agency and a customer concurrently edit and revise a draft of a printed product is old and well known in the printing art. Therefore, at the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art, to modify Farros to include an editing step comprising conducting a first editing by said printing agency of said first draft of said customer's print job, sending said edited first draft of said customer's print job back to the customer over the Internet, conducting a further revisions to said print job by said customer, sending said revised print job back to the printing agency, conducting a second editing by said printing agency to said revised print job to produce a finalized document, and storing said finalized document in said second memory at said printing agency. The addition of these steps would permit a revision of the customer's print job draft thereby ensuring a quality print job and satisfaction of the customer's particular needs.

Regarding claim 18, Farros teach all the limitations discussed under claim 18 above. Farros do not teach a method for printing text, images and pictures wherein said output device can be a toner type digital printer, a CD-ROM printing device, an ink jet printer or a magnetic optical disk read/write device. However, the examiner takes Official Notice that these output devices are old and well known in the art and are commonly used in connection with a personal computer. Farros suggest combining its method with these output devices in that Farros disclose that its method can be implemented using a personal computer with Internet access (col. 2, lines 42-46). Therefore, at the time of the applicant's invention, it would have been obvious to one of



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ordinary skill in the art, to modify Farros to include output device comprising a toner type digital printer, a CD-ROM printing device, an ink jet printer or a magnetic optical disk read/write device.

Regarding claim 26, Farros teaches an editor that does said editing being specialized in digital imaging, computer software, the internet and preparing a document having text and images for printing (col. 2, lines 25-34).

Regarding claim 27, Farros teaches said editor having access to apparatus for monitoring and modifying text and images submitted by said customer to said editor over the world wide web (Id.).

**12. Claims 20-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chabrow (Chabrow, E. "iPrint: Self-Service Printing," InformationWeek, (December 13, 1999)) in view of Farros (US 5,930,810).**

Regarding claim 20, Chabrow teaches a system for printing a document having text, images and pictures, comprising:

a user computer terminal connected to the Internet (page 1, paragraph 1)<sup>3</sup>;

a printing agency accessible via the Internet by said user computer (page 1, paragraph 1).

Chabrow does not teach an editor connected to said printing agency for editing a manuscript submitted by said user to said printing agency to produce said document having text, images and pictures job, said editor not being said customer. However, Farros teach a system for remotely ordering a printed product wherein the attributes of a saved print job are altered

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<sup>3</sup> Chabrow inherently teaches a user computer terminal connected to the Internet. Chabrow discloses having a user access a Website to design a printed product (page 1, paragraphs 1-3). Because accessing a Website requires the implementation of a computer, Chabrow inherently teaches a user computer terminal connected to the Internet.

electronically and wherein the print job may be printed at a remote location<sup>4</sup> (col. 8, lines 42-67; and Fig. 4). At the time of the applicant's invention, it would have obvious to one of ordinary skill in the art, to modify Chabrow to include the teachings of Farros because an editor connected to said printing agency for editing a manuscript submitted by said user to said printing agency to produce said document having text, images and pictures would provide a means for correcting customer errors prior to transmitting and printing the customer's document.

Chabrow further teaches a first plurality of output devices located at a second plurality of locations distant from said printing agency, each of said first plurality of output devices connected to said printing agency via computer network printing (page 1, paragraphs 3 and 8).

Regarding claim 21, Chabrow and Farros teach all the limitations discussed under claim 20 above. Chabrow does not teach a system for printing a document having text, images and pictures wherein said printing agency comprises: a first memory for storing a manuscript originally submitted by said user prior to editing; and a second memory for storing said finalized document after editing. However, Farros teach creating an electronic file for a draft of a print product and saving a finalized version of the print product on a second storage medium (col. 5, lines 9-20; and col. 11, lines 45-52). At the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art, to modify Chabrow to include the teachings of Farros. A first memory for storing a manuscript originally submitted by said user prior to editing would permit a user to return to a previous print job to make revisions. A second memory for storing said finalized document after editing would provide a means for transmitting the finalized

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<sup>4</sup> As noted under footnote 2, Farros discloses an editor that is distinguishable from the customer.

document to the printing agency thereby making it possible to process the order on multiple occasions without requiring the user to resubmit a product order.

Regarding claim 22, Chabrow further teaches a system for printing a document having text, images and pictures wherein a second plurality of users are transmitting and receiving data and revisions of a plurality of manuscripts simultaneously from said printing agency (page 1, paragraph 3).

Regarding claim 23, Chabrow and Farros teach all the limitations discussed under claim 20 above. Chabrow and Farros do not teach a system for printing a document having text, images and pictures wherein said first plurality of output devices comprise: toner type digital printers; CD-ROM printing devices; ink jet type printers; and magnetic optical disk read/write devices. However, the examiner takes Official Notice that these output devices are old and well known in the art and are commonly used in connection with a personal computer. Farros suggest combining its system with an output device comprising a toner type digital printer, a CD-ROM printing device, an ink jet printer or a magnetic optical disk read/write device in that Farros disclose that its method can be implemented using a personal computer with Internet access (col. 2, lines 42-46). Therefore, at the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art, to modify Chabrow and Farros to include output device comprising a toner type digital printer, a CD-ROM printing device, an ink jet printer or a magnetic optical disk read/write device.

Regarding claim 24, Chabrow and Farros teach all the limitations discussed under claim 20 above. Chabrow does not a system for printing a document having text, images and pictures wherein said first plurality of output devices print at a rate of 180 sheets per minute. The

examiner notes that the limitation "wherein said output device prints 180 sheets per minute" is functional claim language and carries little weight because it does not provide any physical limitation. Moreover, Farros teach an output device that is reasonably capable of printing 180 sheets per minute (col. 2, lines 27-32). Therefore, at the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art, to modify Chabrow to include the teachings of Farros in order to obtain high volume output in order to decrease service lead time.

**13. Claims 9, 14, 15 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farros (US 5,930,810) in view of Chabrow (Chabrow, E. "iPrint: Self-Service Printing," InformationWeek, (December 13, 1999)).**

Regarding claims 9 and 14, Farros teach all the limitations discussed under claims 8 and 11 above. Farros do not teach an Internet printing apparatus wherein editing comprises correcting misspellings, correcting typographical errors, and correcting unreadable characters due to different software computer programs and/or different font environment. However, Chabrow teaches a system for ordering print products via an Internet Website wherein users proofread print product orders before the orders are submitted (page 1, paragraph 3). Farros suggest incorporating an editing step comprising correcting misspellings, correcting typographical errors, and correcting unreadable characters due to different software computer programs and different font environment in that Farros disclose having a user perform a final verification of a print job order (col. 3, lines 10-14). Therefore, at the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art, to modify Farros to include the teachings of Chabrow. Not only is this combination suggested by Farros, but correcting misspellings, correcting typographical errors, and correcting unreadable characters

due to different software computer programs and different font environment would avoid the printing of a erred print product and subsequent reworking.

Regarding claim 15, Farros and Chabrow teach all the limitations discussed under claim 14 above. Farros and Chabrow do not teach a method for printing text, images and pictures wherein said editing step is further comprised of formatting page margins, line spacing, font size, page numbering, line numbering, and paragraph numbering. However, the examiner takes Official Notice that these steps are typical editing steps and are old and well known in the art. Therefore, at the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art, to modify Farros and Chabrow to include an editing step further comprising formatting page margins, line spacing, font size, page numbering, line numbering, and paragraph numbering in order to provide a printed product that satisfies the customer's requirements.

Regarding claim 19, Farros teach all the limitations discussed under claim 11 above. Farros further teach an output device located at a second location distant from said printing agency (Abstract; col. 10, lines 41-46), said output device being connected by network printing to said second memory of said printing agency that stores said document for output (col. 11, lines 7-11 and 45-52). Farros do not expressly teach a plurality of output devices located at a second plurality of locations distant from said printing agency. However, Chabrow teaches transmitting print orders to a plurality of commercial printers over the Internet. At the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art, to modify Farros with the teachings of Chabrow because the addition of a plurality of output devices located at a second plurality of locations distant from said printing agency would enable the printing agency to select from a number of print service providers. This would allow the printing agency to

select a print service provider that offers the lowest cost or the shortest lead time. This modification would also afford the printing agency a wider range of options for locating a print service provider that is capable of filling specialized or high-volume orders.

14. **Claims 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chabrow (Chabrow, E. "iPrint: Self-Service Printing," InformationWeek, (December 13, 1999)) in view of an article published in PR Newswire ("New Internet Approved to Streamline Process for Editing Documents on Web" PR Newswire (December 8, 1999)) (PR Newswire).**

Regarding claim 28, Chabrow teaches a system comprising:

customer's personal computer connecting said customer to the internet;

a printing agency having a web page accessible by said customer via the internet enabling said customer to access programs at said print agency to create a document having text and images, enabling said customer to store said document in a first memory at said printing agency, enabling said customer to specify print information and enabling said customer to obtain a price quote for a printing of said document; and

a plurality of output devices located at a corresponding plurality of locales distant from said print agency, each of said plurality of output devices connected to said print agency by a computer printing network, each of said plurality of devices used to print said document stored in said second memory.

Chabrow does not expressly teach an editor at said printing agency having access to software and hardware to monitor, evaluate and modify said document created by said customer at said user terminal and to store said modified document in a second memory at said printing

agency. However, PR Newswire teaches a system for collaboratively editing documents over the Internet. At the time of Applicants' invention, it would have been obvious to one of ordinary skill in the art, to modify Chabrow to include the teachings of PR Newswire because including an editor at said printing agency having access to software and hardware to monitor, evaluate and modify said document created by said customer at said user terminal and to store said modified document in a second memory at said printing agency would enable the customer to improve the quality of their documents.

Regarding claim 29, Chabrow teaches said print information comprising the number of copies to be printed and the media to be printed on.

15. **Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chabrow in view of PR Newswire and Official Notice.**

Chabrow and PR Newswire teach all the limitations discussed under claim 29. Chabrow and PR Newswire do not expressly teach said print information comprising the number of copies to be printed and the media to be printed on. However, the Examiner takes Official Notice that indicating these in a customer print job order is old and well known in the art. Therefore, at the time of Applicant's invention, it would have been obvious to one of ordinary skill in the art, to modify Chabrow and PR Newswire to include said print information comprising the number of copies to be printed and the media to be printed on in order to provide the print service with a complete customer order.

16. **Claims 31-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chabrow in view of ~~PR Newswire~~ Goldberg et al. (US 6,196,146) ("Goldberg") and Official Notice.**

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Regarding claims 31 and 32, Chabrow teaches a method of printing, said method comprising accessing a home page of a print service through the Internet.

Chabrow does not expressly teach:

sending a cost request from a user through the Internet to the print service, the cost request corresponding to a request for an estimate of a cost of a print job, the cost request including first data about the print job;

generating a cost estimate in dependence upon the stored cost request, sending the cost estimate through the Internet to the user, the cost estimate including identification data and including the estimate of the cost of the print job;

when the user receives and approves the cost estimate, sending the identification data and second data about the print job from the user through the Internet to the print service, the second data including print data to be recorded on recordable media.

However, Goldberg teaches a method of providing a customized product to a user over the Internet, including the steps of receiving a request for a quote and transmitting a cost estimate to the user in response to the request (Abstract; and col. 5, lines 25-27). At the time of Applicant's invention, it would have been obvious to one of ordinary skill in the art, to modify Chabrow to include the teaching of Goldberg in order to provide customers with an estimated cost for their custom print job. Thus, customers would be permitted to compare vendors according to price.

Note neither Chabrow nor Goldberg teach when the cost request is received by the print service, storing the cost request. However, the Examiner takes Official Notice that storing service order price information in a file is old and well known in the art. Therefore, at the time



of Applicant's invention, it would have been obvious to one of ordinary skill in the art, to modify Chabrow and Goldberg to include when the cost request is received by the print service, storing the cost request in order to process the request at a later time.

Chabrow further teaches: when the second data and the identification data are received by the print service, storing the print data; storing the print data in the final form; outputting the print data in the final form to a printing location; recording the print data in the final form on the recordable media at the printing location; and receiving the recordable media bearing the print data.

The combination of Chabrow and Goldberg do not expressly teach when the stored print data is not in a final form, performing a first editing of the stored print data, the first editing being performed by an editor and not by the user. However, PR Newswire teaches a system for collaboratively editing documents over the Internet. At the time of Applicants' invention, it would have been obvious to one of ordinary skill in the art, to modify Chabrow and Goldberg to include the teachings of PR Newswire because including an editor at said printing agency having access to software and hardware to monitor, evaluate and modify said document created by said customer at said user terminal and to store said modified document in a second memory at said printing agency would enable the customer to improve the quality of their documents.

Regarding claim 33, Chabrow, Goldberg and PR Newswire teach all the limitations discussed under claim 32. Chabrow further teaches the cost request including a name of the user, the printing location, and a type of recordable media of the print job. Chabrow does not expressly teach, a number of pages of the print job, a number of copies of the print job, a type of binding of the print job. However, the Examiner takes Official Notice that these are common

parameters that are indicated by a customer when ordering a print job. Therefore, at the time of Applicant's invention, it would have been obvious to one of ordinary skill in the art, to modify Chabrow, Goldberg and PR Newswire to include a number of pages of the print job, a number of copies of the print job, a type of binding of the print job in order to enable customers to provide complete order information.

Regarding claim 34, Chabrow, Goldberg and PR Newswire teach all the limitations discussed under claim 33. Chabrow further teaches the printing location corresponding to a selected printing location selected from among a plurality of available printing locations, said outputting of the print data to the printing location corresponding to outputting the print data through the Internet to the printing location. The combination of Chabrow, Goldberg and PR Newswire does not expressly teach the selected printing location being the printing location geographically nearest to the user. However, the Examiner takes Official Notice that providing a custom item to a user based on the user's location is old and well known in the art. Therefore, at the time of Applicant's invention, it would have been obvious to one of ordinary skill in the art, to modify combination of Chabrow, Goldberg and PR Newswire to include the selected printing location being the printing location geographically nearest to the user. This would enable the printing service to provide the print product to the customer at the most convenient location possible.

Regarding claim 35, Chabrow, Goldberg and PR Newswire teach all the limitations discussed under claim 34. The combination of Chabrow and Goldberg does not expressly teach:

after the editor performs the first editing of the print data, sending the edited print data through the Internet to the user;

when the user receives the edited print data, revising the print data, said revising being performed by the user and not by the editor;

sending the revised print data from the user through the Internet to the print service; and performing an additional editing of the print data to place the print data in the final form, the additional editing being performed by the editor and not by the user.

However, PR Newswire teaches a system for enabling a plurality of users to collaboratively edit documents over the Internet. At the time of Applicant's invention, it would have been obvious to one of ordinary skill in the art, to modify Chabrow and Goldberg to include the teachings of PR Newswire in order to enable customers to improve the quality of their documents.

Regarding claim 36, Chabrow further teaches storing of the print data corresponding to storing the print at the print service. The combination of Chabrow, Goldberg and PR Newswire does not expressly teach storing the cost request corresponding to storing the cost request at the print service. However, the Examiner takes Official Notice that storing service order price information in a file is old and well known in the art. Therefore, at the time of Applicant's invention, it would have been obvious to one of ordinary skill in the art, to modify Chabrow and Goldberg to include when the cost request is received by the print service, storing the cost request in order to process the request at a later time.

Regarding claim 37, Chabrow, Goldberg and PR Newswire teach all the limitations discussed under claim 31. The combination of Chabrow and Goldberg does not expressly teach:

after the editor performs the first editing of the print data, sending the edited print data through the Internet to the user;

when the user receives the edited print data, revising the print data, said revising being performed by the user and not by the editor;

sending the revised print data from the user through the Internet to the print service; and performing an additional editing of the print data to place the print data in the final form, the additional editing being performed by the editor and not by the user.

However, PR Newswire teaches a system for enabling a plurality of users to collaboratively edit documents over the Internet. At the time of Applicant's invention, it would have been obvious to one of ordinary skill in the art, to modify Chabrow and Goldberg to include the teachings of PR Newswire in order to enable customers to improve the quality of their documents.

**17. Claims 38 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldberg, in view of Chabrow and PR Newswire.**

Regarding claim 38, Goldberg teaches an apparatus for printing, the apparatus comprising:

a server with a corresponding home page accessible through the Internet, said server receiving a cost request through the Internet from a user, the cost request including a request for an estimate of a cost of a job and including identification data corresponding to the user, the cost request including first data about the job;

said server sending a cost estimate through the Internet to a destination corresponding to the identification data, the cost estimate being generated in dependence upon the received cost request, the cost estimate including the estimate of the cost of the job, said server receiving the print data through the Internet from the user when the user receives and approves the cost

estimate, the print data being the information to be recorded on recordable media (Abstract; col. 5, lines 25-30).

Goldberg does not expressly teach providing a cost estimate for a printing job. However, the Examiner notes it would have been obvious to modify Goldberg to provide cost estimates for printing jobs in order to expand the scope of application of Goldberg.

Goldberg does not expressly teach providing a customized good comprising a printed product. However, because Golberg provides cost estimates for customized products, it would have been obvious to apply Golberg to the providing of cost estimates for printed products.

Goldberg does not expressly teach an editing unit being in communication with said server, said editing unit editing the print data received by said server through the Internet from the user when the print data is not in a final form, said editing unit being distinguishable from the user. However, PR Newswire teaches a system for collaboratively editing documents over the Internet. At the time of Applicants' invention, it would have been obvious to one of ordinary skill in the art, to modify Chabrow to include the teachings of PR Newswire because including an editor at said printing agency having access to software and hardware to monitor, evaluate and modify said document created by said customer at said user terminal and to store said modified document in a second memory at said printing agency would enable the customer to improve the quality of their documents.

The combination of Goldberg and PR Newswire does not teach a second memory unit storing the print data when the print data is in the final form, said second memory unit being in communication with said editing unit; and an output device receiving the print data in the final form from said second memory unit, and recording the print data in the final form on the

recordable media. However, Chabrow teaches a system for providing customized print products over the Internet wherein customers' print parameters are stored on a variety of tangible media. At the time of Applicant's invention, it would have been obvious to one of ordinary skill in the art, to modify Golberg and PR Newswire to include a second memory unit storing the print data when the print data is in the final form, said second memory unit being in communication with said editing unit; and an output device receiving the print data in the final form from said second memory unit, and recording the print data in the final form on the recordable media in order to store customer's custom order parameters, and then reduce the order to its tangible requested form.

The Examiner takes Official Notice that the use of a password for accessing the customer's estimate is old and well known in the art. Therefore, at the time of Applicant's invention, it would have been obvious to modify Goldberg, PR Newswire and Chabrow to include the use of a password in order to provide security to the customer's order information.

The Examiner also takes Official Notice of the fact that storing customer order profile information on a remote database is old and well known in the art. Therefore, at the time of Applicant's invention, it would have been obvious to modify Goldberg, PR Newswire and Chabrow to include a first memory unit storing the cost request and the identification data received from said server, said first memory unit being in communication with said server. This combination would enable customers to access their information at a later date.

Regarding claim 43, Goldberg, and Chabrow teach all the limitations discussed under claim 38. Goldberg, and Chabrow do not expressly teach said server sending the edited print data through the Internet to the user after said editing unit performs the editing of the print data,

the user receiving the edited data through the Internet and revising the edited print data and sending the revised print data to said server, said editing unit further revising the revised print data received by said server from the user to place the revised print data in the final form.

However, PR Newswire teaches a system for collaboratively editing documents over the Internet.

At the time of Applicants' invention, it would have been obvious to one of ordinary skill in the art, to modify Chabrow to include the teachings of PR Newswire because including an editor at said printing agency having access to software and hardware to monitor, evaluate and modify said document created by said customer at said user terminal and to store said modified document in a second memory at said printing agency would enable the customer to improve the quality of their documents.

**18. Claims 39-42 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldberg, in view of Chabrow, PR Newswire and Official Notice.**

Regarding claim 39, Goldberg, Chabrow and PR Newswire teach all the limitations discussed under claim 38. Goldberg, Chabrow and PR Newswire do not expressly teach the identification data corresponding to an e-mail address of the user. However, the Examiner takes Official Notice that providing a customer contact information, including an e-mail address, is old and well known in the art. Therefore, at the time of Applicant's invention, it would have been obvious to one of ordinary skill in the art, to modify Goldberg, Chabrow and PR Newswire to include the identification data corresponding to an e-mail address of the user in order to provide a convenient means for contacting customers.

Regarding claim 40, Goldberg, Chabrow and PR Newswire teach all the limitations discussed under claim 39. Goldberg and PR Newswire do not teach said output device

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corresponding to a selected output device selected from among a plurality of available output devices, said output device receiving the print data through the Internet from said second memory unit. However, Chabrow teaches transmitting a print order from a printing service to a remotely located printing facility. At the time of Applicant's invention, it would have been obvious to one of ordinary skill in the art, to modify Goldberg and PR Newswire to include the teachings of Chabrow in order to outsource printing jobs when special printing needs are required.

The Examiner takes Official Notice of the fact that selecting a service provider based on their geographical location is old and well known in the art. Therefore, at the time of Applicant's invention, it would have been obvious to one of ordinary skill in the art, to modify Goldberg, Chabrow and PR Newswire to include selecting the output device \geographically nearest to the user. This would provide the user with the most convenient pick-up location.

Regarding claim 41, Goldberg, Chabrow and PR Newsire teach all the limitations discussed under claim 38. Goldberg, and Chabrow do not expressly teach said server sending the edited print data through the Internet to the user after said editing unit performs the editing of the print data, the user receiving the edited data through the Internet and revising the edited print data and sending the revised print data to said server, said editing unit further revising the revised print data received by said server from the user to place the revised print data in the final form. However, PR Newswire teaches a system for collaboratively editing documents over the Internet. At the time of Applicants' invention, it would have been obvious to one of ordinary skill in the art, to modify Chabrow to include the teachings of PR Newswire because including an editor at said printing agency having access to software and hardware to monitor, evaluate and modify



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said document created by said customer at said user terminal and to store said modified document in a second memory at said printing agency would enable the customer to improve the quality of their documents.

Regarding claim 42, Golberg teaches said editing unit generating the cost estimate (Abstract).

Regarding claim 44, Chabrow, Goldberg and PR Newswire teach all the limitations discussed under claim 38. Chabrow further teaches the cost request including a name of the user, the printing location, and a type of recordable media of the print job. Chabrow does not expressly teach, a number of pages of the print job, a number of copies of the print job, a type of binding of the print job. However, the Examiner takes Official Notice that these are common parameters that are indicated by a customer when ordering a print job. Therefore, at the time of Applicant's invention, it would have been obvious to one of ordinary skill in the art, to modify Chabrow, Goldberg and PR Newswire to include a number of pages of the print job, a number of copies of the print job, a type of binding of the print job in order to enable customers to provide complete order information.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tim Brown whose telephone number is (703) 305-1912. The examiner can normally be reached on Monday - Friday, 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on (703) 308-1344. The fax phone numbers for the

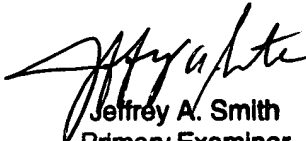
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organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Tim Brown  
Examiner  
Art Unit 3625

TB  
March 7, 2003



Jeffrey A. Smith  
Primary Examiner